

Remarks

This Application has been carefully reviewed in light of the Office Action mailed December 21, 2005. Applicants appreciate the Examiner's consideration of the Application. Applicants have made clarifying amendments to Claims 1-3, 10, 12-14, 19, and 28. At least certain of these amendments are not considered narrowing, and none is considered necessary for patentability. Claims 8, 16-18, and 25-27 have been canceled without prejudice or disclaimer. Additionally, Applicants have added new independent Claims 34-37, none of which are believed to add any new matter. Applicants respectfully request reconsideration and allowance of all pending claims and consideration and allowance of all new claims.

I. Pending Claims 1-7, 9, and 12-15 are Allowable over Gerth

The Examiner rejects Claims 1-7, 9, and 12-15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,370,373 to Gerth, et al. ("*Gerth*"). Applicants respectfully disagree and discuss independent Claim 1 as an example.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131. As illustrated below, *Gerth* fails to disclose, either expressly or inherently, each and every limitation recited in Applicants' Claim 1, as is required under the M.P.E.P. and governing Federal Circuit cases.

Among other distinctions, *Gerth* fails to disclose, teach, or suggest "a plurality of device agents, each device agent being assigned to collect association information from a corresponding set of access points in the wireless network and operable to collect the association information from the corresponding set of access points by querying the access points in the corresponding set of access points," as recited in Claim 1 as amended.

The Examiner apparently equates the mobile users disclosed in *Gerth* with the mobile devices recited in Claim 1. The Examiner also apparently equates the gateways allegedly

disclosed in *Gerth* with the access points recited in Claim 1. The Examiner also apparently equates the mobile switching centers (MSCs) disclosed in *Gerth* with the device agents recited in Claim 1. The Examiner also apparently equates the PCS Service Management System (PSMS) and clone detection system (CDS) disclosed in *Gerth* the device manager and conflict resolution engine, respectively, as recited in Claim 1. Moreover, the Examiner apparently equates the registration notification (REGNOT) disclosed in *Gerth* with the association information recited in Claim 1. (*See* Office Action at 2-3)

Even assuming for the sake of argument only that these equations are appropriate (which Applicants do not concede), *Gerth* does not disclose, teach, or suggest that the MSCs (which the Examiner equates with the device agents recited in Claim 1) are “operable to collect the association information from the corresponding set of access points by querying the access points in the corresponding set of access points,” as are the device agents recited in Claim 1. For example, assuming for the sake of argument only that the REGNOT disclosed in *Gerth* could be equated with the association information (as asserted by the Examiner), the MSCs disclosed in *Gerth* (which the Examiner equates with the device agents recited in Claim 1) do not query the gateways disclosed in *Gerth* (which the Examiner apparently equates with the access points recited in Claim 1) in the corresponding set of gateways to collect the REGNOTs from the corresponding set of gateways.

Instead, *Gerth* merely discloses that a mobile user registers with an MSC by sending its MIN and ESN, presumably via the gateway. This information is sent at a predetermined time interval while the mobile user is operating to notify the MSC of its presence within the cell where the MSC is located. This MIN and ESN information is the REGNOT disclosed in *Gerth* and is apparently sent to the MSC at the initiation of the mobile user. (*See Gerth*, 4:19-26)

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of independent Claim 14 and its dependent claims.

II. Pending Claims 10-11, 19-22, 24, and 28-33 are Allowable over the Proposed Gerth-Iyer Combination

The Examiner rejects Claims 10-11, 19-22, 24, and 28-33 under 35 U.S.C. § 103(a) as being unpatentable over *Gerth* in view of U.S. Patent 6,904,278 to Iyer ("*Iyer*"). Applicants respectfully disagree and discuss independent Claim 19 as an example.

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. *See* M.P.E.P. § 2143. In the present case, the Examiner has failed to prove a *prima facie* case of obviousness for at least two reasons. First, assuming for the sake of argument that the Examiner has shown the requisite teaching suggestion, or motivation in the cited references to combine or modify *Gerth* with *Iyer* in the manner the Examiner proposes, the proposed *Gerth-Iyer* combination still fails to disclose, teach, or suggest each and every element of the claimed invention. Second, Applicants respectfully submit that the Examiner has not shown the requisite teaching, suggestion, or motivation to combine or modify *Gerth* with *Iyer* in the manner the Examiner proposes.

A. The Proposed *Gerth-Iyer* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Independent Claim 19

First, *Gerth*, whether considered alone or in combination with *Iyer*, fails to disclose, teach, or suggest various limitations recited in independent Claim 19. *See* M.P.E.P. § 2143.03. The proposed *Gerth-Iyer* combination fails to support a *prima facie* case of obviousness for at least this reason.

At a minimum, the proposed *Gerth-Iyer* combination fails to disclose, teach, or suggest the following limitations recited in Claim 19:

- collecting association information from access points by querying the plurality of access points for the association information, the association information from an access point comprising information identifying a current association between the access point and an associated wireless device; and

- providing a visualization of current associations between the access points and corresponding associated wireless devices

For example, the proposed *Gerth-Iyer* combination fails to disclose, teach, or suggest “collecting association information from access points by querying the plurality of access points for the association information, the association information from an access point comprising information identifying a current association between the access point and an associated wireless device,” as recited in Claim 19. For at least certain reasons analogous to those discussed above with reference to independent Claim 1, Applicants respectfully submit that *Gerth* fails to disclose, teach, or suggest “collecting association information from access points *by querying the plurality of access points for the association information*, the association information from an access point comprising information identifying a current association between the access point and an associated wireless device,” as recited in Claim 19.

As another example, *Gerth* fails to disclose, teach, or suggest “providing a visualization of current associations between the access points and corresponding associated wireless devices,” as recited in Claim 19. The Examiner apparently acknowledges this deficiency of *Gerth*. (See Office Action at 5-6) However, the Examiner argues that *Iyer* discloses “providing a visualization of current associations between access points and corresponding associated wireless devices,” as recited in Claim 19. Applicants respectfully disagree.

First, for reasons discussed below in Section II.B, Applicants respectfully submit that the Examiner has not demonstrated the requisite teaching, suggestion, or motivation to combine or modify *Gerth* with *Iyer* in the manner the Examiner proposes.

Second, the cited portion of *Iyer* fails to disclose, teach, or suggest, “providing a visualization of current associations between access points and corresponding associated wireless devices,” as recited in Claim 19. The cited portion of *Iyer* (16:19-48) discloses generating a graphical representation of a Corsair Phoneprint Tear Down Report. (16:19-23, 31-32) The Examiner has provided no evidence or explanation as to how, nor does the cited portion of *Iyer* disclose, teach, or suggest that, the graphical representation of the Corsair

Phoneprint Tear Down Report can be equated with a visualization “of *current associations* between *access points* and *corresponding associated wireless devices*,” as recited in Claim 19.

For at least these reasons, the proposed *Gerth-Iyer* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 19.

B. The Proposed *Gerth-Iyer* Combination is Improper

Second, the rejection of independent Claim 19 (and its dependent claims) is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Gerth*, *Iyer*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify the *Gerth* or *Iyer* in the manner the Examiner proposes. The rejected claims are allowable for at least this additional reason.

1. The Obviousness Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Gerth-Iyer* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Respectfully, it appears to Applicants that the Examiner has pieced together disjointed portions of references, with the benefit of hindsight using Applicants’ claims as a blueprint, in an attempt to reconstruct Applicants’ claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* ***Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, ***“The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.”*** M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this

methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. Argument

The Examiner states:

In an analogous art, Iyer discloses a topology service adapted to provide a visualization of current associations between the access points and the mobile units, through a graphical user interface (Iyer, Col. 16, lines 19-48 and Fig. 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Iyer to the system of Gerth in order to provide a way to combine data files related to call data in a report format, such as a graphical representation, that can be readily analyzed to permit resolution of problems in a wireless network because graphical representations are user-friendly and very easy to understand, facilitating intellectual comprehension.

(Office Action at 6) While the Examiner cites a portion of *Iyer* for its alleged disclosure of “a topology service adapted to provide a visualization of current associations between access points and corresponding associated wireless devices,” the Examiner does not provide any citation as allegedly providing the requisite teaching, suggestion, or motivation for combining or modifying *Gerth* with *Iyer* in the manner the Examiner proposes. Applicants respectfully submit that the Examiner’s assertion that it would have been obvious to combine the teachings of *Gerth* with the teachings of *Iyer* to purportedly arrive at Applicants’ invention is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

It appears that the Examiner has merely proposed an alleged advantage of combining *Iyer* with *Gerth* (an advantage which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of the cited references (or to knowledge of one of ordinary skill in the art at the time of Applicants’ invention) that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the cited technique for generating a graphical representation of a Corsair Phoneprint Tear Down Report, as disclosed in *Iyer*, with the particular system and method for detecting cloning fraud in cellular/PCS communications, as disclosed in *Gerth*.

In other words, the alleged advantage asserted by the Examiner does not provide a supported explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants’ invention (*without using Applicants’ claims as a guide*) to modify the particular techniques disclosed in *Gerth* with the cited disclosure in *Iyer*; (2) how one of ordinary skill in the art at the time of Applicants’ invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 19. Indeed, if it were sufficient for Examiners to merely assert an advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

It certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the particular system and method for detecting cloning fraud in cellular/PCS communications disclosed in *Gerth* with the particular technique for generating a graphical representation of a Corsair Phoneprint Tear Down Report disclosed in *Iyer* in the manner proposed by the Examiner.² Applicants respectfully submit that the Examiner's attempt to modify or combine *Gerth* with *Iyer* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Moreover, the fact that two reference may be in an analogous art, as asserted by the Examiner in this case (a point which Applicants do not concede), is insufficient to provide the requisite teaching, suggestion, or motivation to combine or modify references. Applicants reiterate that "[t]he factual inquiry whether to [modify] references must be thorough and searching." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Any "conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* The Examiner's conclusory assertion of a perceived advantage of one of the references and the Examiner's statement that the two references are analogous art (even if true) do not provide an adequate "factual inquiry." The Examiner gives no technical reasoning as to why or how these systems can be combined and, if combined, would be successfully combined. Thus, this reasoning surely cannot be said to be "thorough and searching."

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Gerth* with *Iyer* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

² If "common knowledge" or "well known" art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

C. Conclusion with Respect to the Section 103 Rejections

For at least these reasons, Applicants respectfully submit that the proposed *Gerth-Iyer* combination does not support a *prima facie* case of obviousness. Thus, Applicants respectfully request reconsideration and allowance of independent Claim 19 and its dependent claims. For at least certain analogous reasons, Applicants respectfully request reconsideration and allowance of Claims 10-11 and 28-33.

III. Claim 23 is Allowable over the Proposed Gerth-Wu Combination

The Examiner rejects Claim 23 under 35 U.S.C. § 103(a) as being unpatentable over *Gerth* in view of U.S. Patent Publication 2003/0185244 A1 to Wu, et al. ("*Wu*"). Applicants respectfully disagree.

Claim 23 depends from independent Claim 19, which Applicants have shown above to be clearly allowable over the proposed *Gerth-Iyer* combination. *Wu* fails to make up for at least those deficiencies of *Gerth* discussed above with respect to independent Claim 19. Thus, Claim 23 is allowable at least because of its dependence on independent Claim 19. Moreover, neither *Gerth* nor *Wu* discloses, teaches, or suggests "providing a visualization of current associations between the access points and corresponding associated wireless devices," as recited in independent Claim 19. Thus, dependent Claim 23 is certainly allowable over the proposed *Gerth-Wu* combination. Additionally, dependent Claim 23 recites further patentable distinctions over the proposed *Gerth-Wu* combination. To avoid burdening the record and in view of the clear allowability of independent Claim 19, Applicants do not specifically discuss these distinctions in this Response. However, Applicants reserve the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Moreover, Applicants do not admit that the proposed *Gerth-Wu* combination is even possible or that the Examiner has shown the requisite teaching, suggestion, or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of invention to combine or modify these references in the manner the Examiner proposes.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claim 23.

IV. New Claims 34-37 are Allowable

New independent Claims 34 and 36 are directed to software and are allowable for at least certain reasons analogous to those discussed above with respect to independent Claims 14 and 19, respectively. New independent Claims 35 and 37 are directed to computer systems and are allowable for at least certain reasons analogous to those discussed above with respect to independent Claims 14 and 19, respectively. For at least these reasons, Applicants respectfully request consideration and allowance of new independent Claims 34-37.

V. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

Conclusion

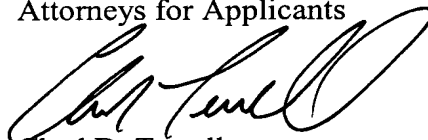
Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicants, at the Examiner's convenience at (214) 953-6813.

A check in the amount of \$800.00 is enclosed to cover the cost of four new independent claims total over three. Although Applicants believe no other fees are due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: March 21, 2006

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